APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,701	06/01/2001	Steven W. Lundberg	296.022US1	2505

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER
COBY, FRANTZ

ART UNIT	PAPER NUMBER
2161	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/872,701	LUNDBERG, STEVEN W.
	Examiner	Art Unit	
	Frantz Coby	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 March 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-96</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-96</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

This is in response to Applicant's amendment filed on March 27, 2006 in which claims

1-96 are presented for examination.

Status of Claims

Claims 1-96 are pending of which claims 1, 25, 49 and 73 are independent claims.

Response to Arguments

Applicant's arguments filed on the aforementioned date have been fully

considered but they are not persuasive. Therefore the rejection of claims 1-96 under

section 103(a) mailed on October 25, 2005 remains.

The rejection follows:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-13, 15-61 and 63-96 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Simpson et al (Simpson), US 6,549,894, 15 April 2003 and

Schneider, US 5,987,464, 16 November 1999.

Simpson is directed to a computerized docketing system that includes tracking

and docketing patent applications (COL 1 line 66 and after). Simpson does not explicitly

address access to the system over the Internet, although as shown in FIG 1-9, the

preferred embodiment is a Windows system as commonly applied in a PC used as a

workstation. Schneider is directed to updating data records having an expiry time (COL

1 lines 9-12), which includes patent information ICOL 2 lines 15-20). Schneider does not

address the details of managing docketing tasks during prosecution. However,

Schneider discussed the general utility of having subscribers to an updating service use

an on-line system (COL 1 lines 15-40*, COL 4 lines 54-61, COL 11 lines 58-65).

Official Notice is taken that law firms that prosecute patent applications are distributed

over sites that may be remote from each other. It would have been obvious to one of

ordinary skill in the art at the time of the invention to provide access to the system of

Simpson through the Internet as set forth by Schneider because docketing information

is time sensitive information, and the combination allows docketing information to be

tracked and appropriate alerts issued remotely.

As to claim 1:

A system for managing patent application data via the Internet, comprising a

matter module, the matter module operable to manage data relating to patent matters,

the managed data comprising docketing data, the docketing data generated within the

system, the docketing data generation based on patent laws and rules governing patent

prosecution.

Simpson teaches the use of matters modules (COL 5 lines 7-27).

a tasks module, the tasks module operable to manage tasks related to each matter managed by the matter module, the tasks comprising docketing tasks and other tasks generated automatically within the system and based on patent laws and rules governing patent prosecution;

Typical tasks associated with matters are set forth in Simpson at COL 1 line 66 to COL 2 line 36,

a security module, the security module operable to restrict Internet access to patent application task and matter data management to selected system users; and As set forth by Simpson at COL 5 lines 28-48, users are limited by security concerns in various ways.

Simpson does not specify that this function is a module per se, but clearly it is a specific function that can be organized and managed as a module for purposes of efficiency in coding and maintenance. The users in the combined system have access over the Internet.

a messaging module operable to provide messaging to users of the system wherein messages are sendable from within matters in the matter module and accessible within matters.

Simpson provides messages concerning due dates in a color format to users (COL 5 lines 51-67). Schneider displays messages over the Internet and also applies email to communicate with users ICOL 12 lines 15-33).

As to claims 2-13, creating, retrieving and editing of tasks and particular matters are necessary functions of the system of both Simpson and Schneider. Attorneys of particular organizations and/or inventors or other users specify particular applications and/or patent interests (Simpson COL 7 lines 1-12 and elsewhere). Simpson displays a calendar (claim 11). Login is the initial act of a user of a PC or workstation connected through the Internet (claim 12).

As to claim 16, Simpson teaches that multiple users are sent reports generated by one/or more of them (COL 3 lines 4-17, lines 40-52).

As to claim 20, neither Simpson or Schneider notes the use of Java, but the use of on-line access in Schneider strongly suggests that Java may be applied to develop code.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Java because it is an object-oriented language that is more portable and easier to use that many other languages, it is more robust and manages memory on its own.

As to claims 22-23, Schneider is directed to subscribers connected to the system over the Internet, who may archive data, which is typically done into another database (COL 6 lines 8-14). The data itself may be acquired over the Internet and thus from another database ICOL 5 lines 10-17 and elsewhere).

The elements of claims 15, 17-19, 21, 24-61 and 63-96 are rejected in the analysis

above and these claims are rejected on that basis.

Remarks

The Applicant argued that, "Simpson fails to describe a security module" and

"managing data via the Internet or restricting Internet access to such data". The

Examiner on the other hand disagrees with the preceding argument because as

indicated above, Simpson teaches the use of matters modules (COL 5 lines 7-27). The

Office action is clear on how Simpson achieved the claimed limitations. In particular,

Simpson does not specify that this function is a module per se, but clearly it is a specific

function that can be organized and managed as a module for purposes of efficiency in

coding and maintenance. The users in the combined system have access over the

Internet. Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to provide access to the system of Simpson through the Internet as

set forth by Schneider because docketing information is time sensitive information, and

the combination allows docketing information to be tracked and appropriate alerts

issued remotely.

The Applicant also argued that "neither Simpson not Schneider describe Internet-

based management of data". The Examiner, on the other hand, respectfully submits

that the Office Action is clear on how it would have been obvious to arrive with an

Internet-based management by combining the system of Simpson with the system of

Schneider. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide access to the system of Simpson through the Internet as set forth by Schneider because docketing information is time sensitive information, and the combination allows docketing information to be tracked and appropriate alerts issued remotely.

The Applicant further argued that, "neither reference discussed a security module operable to restrict the ability for an Internet user to manage such data". However, the Examiner disagrees with this line of argument because is clear on how the aforementioned limitation was met by the combination of Simpson/Schneider. In particular, Simpson achieved this claimed feature at COL 5 lines 28-48; in that, users are limited by security concerns in various ways. The Applicant should duly note that Simpson does not specify that this function is a module per se, but clearly it is a specific function that can be organized and managed as a module for purposes of efficiency in coding and maintenance. The users in the combined system have access over the Internet.

Last, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have

been obvious to one of ordinary skill in the art at the time of the invention to provide

access to the system of Simpson through the Internet as set forth by Schneider

because docketing information is time sensitive information, and the combination allows

docketing information to be tracked and appropriate alerts issued remotely.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Frantz Coby whose telephone number is 571 272 4017.

The examiner can normally be reached on Monday-Friday 9:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey Gaffin can be reached on 571 272 4146. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 11, 2006

FRANTZ COBY
PRIMARY EXAMINER